

REMARKS**1. The Amendments and the Support Therefor**

One claim (11) has been canceled, one new claim (21) has been added, and claims 1, 4, 6, 14, 16, and 20 have been amended to leave claims 1-10 and 12-21 in the application. No new matter has been added by the amendments or new claims. For your convenience, following is a summary cross-referencing certain amendments and the new claims to exemplary portions of the specification and/or drawings disclosing the recited structure. A more detailed explanation of these amendments and new claims is provided where it is thought to be helpful:

Claim 1: Amended to incorporate claim 11 (which is now canceled).

Claim 4: Amended to incorporate the feature noted (for example) at page 3 line 17-page 4 line 1, page 7 lines 4-7 and page 11 lines 6-19.

Claim 6: See guide stop 154 (in FIG. 1 of the application).

Claim 14: See handle 166 (in FIGS. 1-2 of the application) connected to upper spray box portion 102.

Claim 16: Amended to incorporate claim 11, and also to incorporate the feature noted (for example) at page 3 line 17-page 4 line 1, page 7 lines 4-7 and page 11 lines 6-19.

Claim 20: Amended to incorporate the feature noted (for example) at page 3 line 17-page 4 line 1, page 7 lines 4-7 and page 11 lines 6-19.

Claim 21: Finds support in claim 11.

2. Sections 1-2 of the Office Action: Rejection of Claim 20 under 35 USC §102(a) in view of U.S. Patent 6,613,147 to Nieto

Claim 20 has been amended to recite that the spray nozzles are removably insertable within desired spray nozzle apertures to achieve spray at desired regions within the spray box. This feature is not taught by *Nieto*, wherein the spray nozzles 38 (see FIG. 4) are situated entirely within the *Nieto* spray box and are held in place by piping 36, which precludes the removal and replacement of the nozzles 38. Thus arrangement is used because *Nieto* describes the use of a conventional paint spray gun 50 (again see FIG. 4 of *Nieto*) to supply the piping with sprayable fluid (see also column 4 lines

25-27), and thus the piping allows convenient hookup of a readily available conventional spray gun to supply all nozzles 38.

It cannot be said that the art of record fairly suggests the claimed arrangement for several reasons. First, the piping 36 and nozzles 38 cannot readily be moved outside of the *Nieto* box, and then made refittable within different spray nozzle apertures situated in the box roof, box floors, and/or box sidewalls. Since the rigid piping would extend about and engage the *Nieto* spray box, it is not even apparent that such an arrangement, once installed, *could* be moved. Thus, an ordinary artisan would see no benefit to modifying *Nieto* to attain the claimed arrangement.

Second, the other references of record, such as U.S. Patent 2,751,879 to *Holtzman*, also do not provide any suggestion to modify *Nieto* to attain the claimed arrangement. In *Holtzman*, the nozzles 53 (see FIG. 4 of *Holtzman*) are held in place within the frame 10 (see FIG. 2), and are instead removably fit within hoods 52/43 (see FIG. 4 and column 2 line 68-column 3 line 16 of *Holtzman*) which direct the spray to desired locations within the frame 10. Thus, *Holtzman* suggests (if anything) that if spray is to be directed to a desired region in a *Nieto* spray box, hoods such as *Holtzman*'s hood 52 should be fit about the *Nieto* nozzles within the *Nieto* spray box – an arrangement which would also be easier to implement in *Nieto* than having the nozzles removably insertable within a variety of spray nozzle apertures. The remaining references of record, such as U.S. Patent 5,685,658 to *Woodruff* and U.S. Patent 2,280,984 to *Thurnau*, also do not provide any fair suggestion to modify *Nieto* in the manner claimed.

In summary, we submit that claim 20 is allowable since (1) the art of record, lacking nozzles which are removably refittable into different apertures in the spray box, cannot be said to suggest such a feature; and (2) an ordinary artisan would see no benefit to modifying *Nieto* to attain the claimed arrangement, since the *Nieto* piping 36 and nozzles 38 cannot be modified to attain the claimed arrangement (or if they can, such an arrangement would be so difficult that no ordinary artisan would see any benefit to this arrangement).

3. Sections 3-5 of the Office Action: Rejection of Claims 1-9, 11-12, 14, and 16-18 under 35 USC §103(a) in view of U.S. Patent 6,613,147 to Nieto and U.S. Patent 2,751,879 to Holtzman

Claim 1 is amended to incorporate claim 11, which recites a hinged connection between upper and lower spray box portions (compare FIGS. 1 and 2 of the present application). The Office Action contends at page 6 that *Holtzman* suggests a similar feature, but this is not the case: in *Holtzman*, the hoods 52 and 43 (see FIG. 2) – which are within *Holtzman*'s frame 10 (spray box), see FIG. 2 – are not connected together by hinges or any other structure (see column 2 line 68–column 3 line 16 of *Holtzman*). Instead, the flange 54 situated about the nozzles 53 and 44 allows the hoods to be independently affixed about the nozzles so that their spacing can be accommodated to allow different board thicknesses to fit therebetween – an objective which could not be attained if the hoods 52 and 43 were affixed together (by hinges or otherwise). Thus, claim 1 (as amended) is not fairly suggested by *Holtzman*, since the hoods 52 and 43 would no longer function for their desired purpose – to allow the space therebetween to be adjusted to allow different board thicknesses to fit therebetween – if they were hinged together. If it is believed that *Holtzman* or another reference of record discloses or suggests the Applicant's claimed hinged relationship, it is respectfully requested that the Office identify with particularity the location and content of the alleged disclosure or suggestion so that the Applicant may better respond.¹

Claim 4 is amended to recite the features noted with respect to claim 20 in Section 2 of this Response, and thus claim 4 is submitted to be independently allowable for at least the same reasons as claim 20.

Claim 6, as amended, is also not taught or suggested by the art of record since the belts 41 of *Holtzman* do not meet the recited description of the guide stops.

¹ "[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference," *In re Rijckaert*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); "When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion to combine references or make the modification," *In re Mayne*, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997).

Claim 9 is also submitted to be allowable because the recited arrangement is not in fact suggested by *Holtzman*. *Holtzman* shows an exit lip 63 (see FIGS. 2-3 and column 3 lines 26-30) and an entry lip (above reference numeral 34 in FIG. 3), but the support rollers 21 and 37 are plainly not mounted thereon. Thus, it is not seen where the art of record suggests the claimed arrangement, and if the rejection of claim 9 is maintained, kindly explain.

Claim 16 is amended to recite the features noted above with respect to claim 20 (see Section 2 of this Response) and also with respect to claim 1, and is submitted to be allowable for the same reasons as these claims. In particular, we submit that the art of record, when considered as a whole, cannot be said to fairly suggest the use of both of the features now recited in claim 16.

Regarding claim 18, the *Nieto* support rollers 54 are plainly *not* provided on the box endwalls, nor is there any suggestion to place them on the box endwalls since they would then not function for their intended purpose of supporting boards away from *Nieto*'s spray box. Thus, the rejection of claim 18 should be withdrawn.

4. Section 6 of the Office Action: Rejection of Claims 10 and 15 under 35 USC §103(a) in view of U.S. Patent 6,613,147 to Nieto, U.S. Patent 2,751,879 to Holtzman, and U.S. Patent 5,685,658 to Woodruff

Claims 10 and 15 are submitted to be allowable for at least the same reasons as claim 1, from which these claims depend.

5. Section 7 of the Office Action: Rejection of Claims 13 and 19 under 35 USC §103(a) in view of U.S. Patent 6,613,147 to Nieto, U.S. Patent 2,751,879 to Holtzman, and U.S. Patent 2,280,984 to Thurnau

Claims 13 and 19 are submitted to be allowable for at least the same reasons as claims 1 and 16, from which these claims depend.

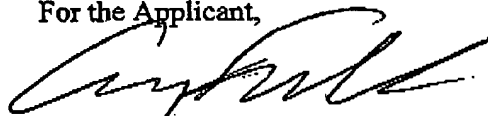
6. New Claim 21

New claim 21, which depends from claim 20, is submitted to be allowable for at least the same reasons as claim 20. Additionally, claim 21 is submitted to be independently allowable for the reasons noted above with respect to claim 1 (as amended to incorporate claim 11).

7. In Closing

If any questions regarding the application arise, please contact the undersigned attorney. Telephone calls related to this application are welcomed and encouraged. The Commissioner is authorized to charge any fees or credit any overpayments relating to this application to deposit account number 18-2055.

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ATTACHMENTS:

• PTO-2038 (\$225)